

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-8, 13-16, 24, 25, and 30-33 are presently active; Claims 9-12, 17-23, 26-29 were previously canceled without prejudice. Claims 1, 5, 13, 31, 32, and 33 have been presently amended.

In the outstanding Office Action, Claims 31 and 32 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement and the enablement requirement. Claim 32 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 1, 3-4, 5, 7-8, 13, 15-16, 30, and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller et al (U.S. Pat. Appl. Publ. No. 2001/0051875) in view of Hartman (U.S. Pat. No. 5,960,411). Claims 2, 6, and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller et al and Hartman in view of Ziarno (U.S. Pat. Appl. Publ. No. 2001/0001855). Claims 24-25 and 33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller et al and Hartman and Ziarno in view of Guhen et al (U.S. Pat. No. 6,473,794). Claim 31 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller et al and Hartman in view of Official Notice.

Regarding the 35 U.S.C. § 112, second paragraph, rejection, Claim 1 has been amended to provide the antecedent basis for the content provider recited in Claim 32. Thus, it is respectfully submitted that the 35 U.S.C. § 112, second paragraph, rejection has been overcome.

Regarding the 35 U.S.C. § 112, first paragraph, rejections, Claims 31 and 32 have been amended to be consistent with those parts of the specification discussed in the Official Action. Thus, the 35 U.S.C. § 112, first paragraph, rejections have been overcome.

Regarding the rejection on the merits, amended Claim 1 presents two new features to clarify the contribution processing device defined therein. One new feature is the receipt over a network of personal content data which were personally created by a content provider. This feature is supported by the specification at page 1 (where the content is defined as being created individually by a user) and by Figure 2 which shows that the content creator is at user PC 2 and the discussion of Figure 2 on page 22 of the specification. The other new feature is to display both of the personal content and the contribution icon, simultaneously. This feature is supported in Applicants' FIGs. 28, 40, 44 and 46.

The Office Action applies Miller et al for their teaching of an online donation management system. However, the donations in Miller et al are to non-profit organizations and **not** to individuals. For instance, Miller et al disclose at numbered paragraph [0032] that:

An overview of the present invention 10, FIG. 1 is a system for soliciting donations via the World Wide Web or Internet. The donor 12 may, if desired, be an individual or an individual representing an organization with a particular interest in a charitable organization. An example of a charitable organization is the Trees Atlanta, the Atlanta Humane Society, the North Shore Animal League or any other non-profit organization that has a presence or website on the Internet. The present invention 10 is installed on a computer or server with Internet access and linked to the charitable organization's 11 website. The charitable organization 11 has cataloged selected items or assets as gifts to the donor 12 by design and with the organization's sole discretion. The catalog listing of these items resides in the present invention's database 14. The charitable organization's 11 website may, if desired, display a banner hyperlink to link to the present invention's 10 website. The donor 12, in communication with the charitable organization 11, selects a donation by activating a link to the present invention's 10 website i.e., clicking on a selectively displayed hyperlink. Transparent to the donor 12, the present invention 10 is now in communication with the donor 12 and the charitable organization's 11 website. The present invention 10 facilitates the donation process, the selection of gifts in response to selected contributions, data input required for payment of the donation, customization of and delivery of the selected gifts.

Thus, while Miller discloses a system for soliciting donations via internet, Miller does not teach or suggest displaying personal content data personally created by a content provider. Furthermore, Miller does not teach or suggest a simultaneous display of both the personal

content data and the contribution icon. Rather, as seen from the above-quoted passage from Miller, in Miller, the charitable organization's 11 website may, if desired, display a banner hyperlink to link to the present invention's 10 website. Before the hyperlink is activated, a contribution icon is not present. After the hyperlink is activated, the content data about the charitable organization is not present.

Hartman was applied in the outstanding Office Action for its teaching of a registered user, a teaching unrelated to the added features discussed above. Nevertheless, in full consideration of Hartman, Hartman does not overcome the deficiencies of Miller. Hartman discloses a system for placing an order to purchase an item that a purchaser desires via internet. Figure 1A of Harman shows a webpage having a summary/detail description of the item and an icon for purchase of the item. However, Hartman does not teach or suggest a user contribution icon (given in consideration for sharing by the content provider of the personal content data) and therefore does not teach the simultaneous display of the defined user contribution icon and the summary/detail description of the item.

For these reasons, independent Claims 1, 5, 13, and 33 (and the claims dependent therefrom) are believed to patentably define over Miller et al and Hartman.

Moreover, the teachings of Hartman for purchasing an item *teaches away* from the present invention. The Court in *KSR International Co. v. Teleflex Inc. et al.* 2007 U.S. LEXIS 4745 reinforced the role of elements worked together in an unexpected and fruitful manner in deciding obviousness. The Court stated that:

In *United States v. Adams*, 383 U. S. 39, 40 (1966), a companion case to *Graham*, the Court considered the obviousness of a wet battery that varied from prior designs in two ways: It contained water, rather than the acids conventionally employed in storage batteries; and its electrodes were magnesium and cuprous chloride, rather than zinc and silver chloride. The Court recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result. 383 U. S., at 50-51. It nevertheless rejected the Government's claim that Adams's battery was obvious. The Court relied upon the corollary

principle that when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious. *Id.*, at 51-52. When Adams designed his battery, the prior art warned that risks were involved in using the types of electrodes he employed. The fact that the elements worked together in ***an unexpected and fruitful manner*** supported the conclusion that Adams's design was ***not obvious*** to those skilled in the art. [Emphasis added.]

In the present case, one would not expect an individual to register himself as a user when making a contribution given in consideration for sharing by the content provider of the personal content data, because the contribution given by the user is given in a gratuitous manner where no more contributions would be normally expected. Thus, ***user registration*** coupled with ***a contribution given in consideration for sharing by the content provider of the personal content data*** (as claimed) are elements which work together in an unexpected and fruitful manner to encourage what otherwise would be unexpected subsequent contributions.

Accordingly, both for the reasons given earlier and for the unexpected and fruitful manner in which the claimed elements work together, independent Claims 1, 5, 13, and 33 (and the claims dependent therefrom) are not obvious in view of Miller et al and Hartman.

Regarding dependent Claim 31 and the Office Action reliance on Official Notice, M.P.E.P. § 2144.03 states that it is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record, as the principal evidence upon which a rejection is based. Accordingly, Applicant traverses the 35 U.S.C. § 103 rejections based on the Official Notice taken in the outstanding Office Action for the reason that, without the temporal and structural context by which these features are known to the artisan, it is impossible to conclude that it would be obvious for one of ordinary skill in the art at the time of the invention to combine this noticed feature with the art of record. Indeed, the context by which these features are allegedly known might itself provide reasons to rebut a *prima facie* case of obviousness. For instance, the outstanding Office Action makes reference to

Nikander (U.S. Pat. No. 6,029,151) for a teaching of using electronic money to make payments. Yet, the very action of making payments electronically for the telephone bill, as disclosed in Nikander, *teaches away* from the present invention's contributions that are given in consideration for sharing by the content provider of the personal content data (in which no payment for the personal content data is required).

Therefore, it is respectfully requested that Nikander be applied and the reasons for combining be set forth on the record or that the Official Notice rejection to Claim 31 be removed.

Consequently, in view of the present amendment and in light of the above discussions, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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